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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,794	03/09/2004	Scan Hancy	D-1218 R3	3177
28995	7590	08/15/2007	EXAMINER	
RALPH E. JOCKE			BUTLER, MICHAEL E	
walker & jocke LPA				
231 SOUTH BROADWAY			ART UNIT	PAPER NUMBER
MEDINA, OH 44256			3653	
			MAIL DATE	DELIVERY MODE
			08/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,794	Applicant(s) HANEY ET AL.	
	Examiner Michael Butler	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-10 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-2 and 11 and 22-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) 12-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03162005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim of priority to application 60/453397 filed 3/10/2003 is acknowledged.

Election/Restriction

2. Applicant's election of invention I with traverse on 4/4/2007 of the restriction requirement of 3/8/2007 is acknowledged and made final.
3. Claims 3-10 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
4. The applicant argues the restriction requirement ought be withdrawn because the examiner will search common base claims in the search of groups I and II. However, the generic claim limitations were located in the search of the Group II claims without searching for nor considering the Group I art. No common prior art anticipating or obviating the group I and II claims was noticed in the search of the Group II claims, further evidencing distinction between groups I and II.
5. The applicant argues the restriction requirement ought be withdrawn because the nothing precludes the addition of the invention of the non-elected groups to the elected group device. This is however not a species requirement, it was a restriction requirement. The inventions need not be mutually exclusive.

The elements claimed within groups II and III lack any affirmative recitation of a gate for blocking the dispensing. The test is not whether the group II and III elements preclude , but whether they support the gate for dispensing the blocking. This is not a species requirement, it

was a restriction requirement. The inventions need not be mutually exclusive as in a species requirement.

The test is not whether groups I and III preclude conveying dispensing to an alternate dispensing port, but rather whether the elements of groups I and III support such a feature-which they don't. Again, this is not a species requirement, it was a restriction requirement. The inventions need not be mutually exclusive as in a species requirement.

Drawings

6. The drawings are acceptable.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1,2, 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bui 6386662 which discloses all the claimed elements including:

(Re: cl 1,25) Apparatus comprising: an automated banking machine including a housing; at least one input device in supporting connection with the housing adapted to receive inputs associated with each user of the machine (inherent with ATM as seen in c2 L 30-48);
a cash dispenser (inherent with ATM as seen in (c2 L 30-48);
a transport adapted to transport deposit items between a deposit opening on the housing and a deposit storage area in the housing (c2 L 30-48)
a printhead operative to print indicia on deposit items that are moved through the transport (c3 L 60-c4 L 13);

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a wiper movably mounted in supporting connection with the housing and adapted to engage the printhead (c3 L 60-c 4 L 13);

a drive in operative connection with a wiper (c3 L 60-c4 L 13);

at least one controller in the housing, wherein the at least one controller is in operative connection with the at least one input device, cash dispenser, transport, printhead and drive, and wherein the at least one controller is operative to cause the wiper to engage the printhead (inherent with ATM)

(Re: cl 2) wherein the wiper comprises a resilient squeegee portion, and wherein the printhead includes ink nozzles, and wherein the squeegee portion moves over the nozzles (inherent with ink clearing function of the wiper)

(Re: cl 26) wherein the deposit items include at least one of deposit envelopes, empty envelopes and sheets (c2 L 49-57).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim(s) 1, 2, 11, 22-23, and 25-27 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Bui 6386662 in view of Graef et al. '682 (5534682) wherein the former discloses the elements previously discussed and the latter discloses any elements not inherently taught by the former including:

(Re: cl 11,27)(2) further comprising a vessel in supporting connection with the housing, wherein the vessel includes an opening in opposed relation of the nozzles, and wherein the vessel opening accepts ink from the nozzles that is not applied to deposit items (c11 L 33-c12 L 25-38; 310 fig 15-19)

(Re: cl 22)(11) wherein the vessel extends above the nozzles, and wherein the vessel includes an internal ink holding cavity, and wherein the cavity extends vertically below the vessel opening (c12 L 25-38)

(Re: cl 23)(11) wherein the vessel is movably mounted in supporting connection with the housing, and wherein the vessel is engaged with and moved by deposit items in the transport (c9 L 20-35).

It would have been obvious for Bui to movably mount a vessel within the housing to secure deposits and direct them to the proper destination as taught by Graef et al. '682 and come up with the instant invention. It would have been obvious for Bui to use a an opening in the vessel to mark items in the vessel as taught by Graef et al. '682 and come up with the instant invention. It would have been obvious for Bui extend the vessel above the nozzles to movably selectively position documents as taught by Graef et al. '682 and come up with the instant invention.

Allowable Subject Matter

11. Claims 12-21 are objected to as being dependent claims premised upon a rejected base claim but would be allowed if the re-written in independent form or if the limitations of an allowable claim were incorporated within the independent base claim from which this claims depend or if re-written premised upon dependence from an otherwise allowable base claim.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (571) 272-6937.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Michael E. Butler". The signature is written in a cursive, flowing style.

Michael E. Butler

Examiner